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Deanna T Ongwela
9231 Redbridge Court
Laurel MD 20723

MAILED

AUG 01 2012

OFFICE OF PETITIONS

In re Patent of Deanne T. Ongwela :
Patent No. 6,669,657 :
Issue Date: December 30, 2003 :
Application No. 09/665,608 :
Filing Date: September 20, 2000 :
For: Massage and Tactile Stimulation :
Device :

Request for Information

This letter responds to a paper filed May 2, 2012.

Background

The patent issued December 30, 2003.

The 7.5 year maintenance fee was due between December 30, 2010, and June 30, 2011, or with a surcharge, from July 1, 2011, to December 30, 2011.

Petitioner's husband passed away during April 2011, and Petitioner closed her small business during June 2011 to take care of her 9-year old son.

As of August 2011, Petitioner was aware of the need to pay the 7.5 year maintenance fee and the required surcharge in order to prevent the expiration of the patent. Petitioner was also aware the 7.5 year fee was \$1,240, and the surcharge was \$65.

Effective September 26, 2011, the 7.5 year maintenance fee for small entities was increased to \$1,425 and the surcharge for submitting a maintenance fee payment during the six-month grace period was increased to \$75. In other words, the total fee due to prevent the expiration of the patent increased from \$1,305 (\$1,240 + \$65) to \$1,500 (\$1,425 + \$75).

During December 2011, Petitioner contacted the Office to clarify the fees owed and learned the fees had been increased.

In papers filed January 27, 2012, Petitioner asserts she was unable to pay the fees prior to receiving a paycheck on January 6, 2012, due to the unexpected significant increase in the fees.

The maintenance fee was not timely paid on or before December 30, 2011, and the patent expired on December 31, 2011.

Petitioner filed a Maintenance Fee Transmittal Form and a Credit Card Authorization Form by facsimile transmission upon receiving the January 6, 2012 check, or very shortly thereafter.

Several days later, Petitioner noticed the Office had not charged any fees to the credit card. Petitioner then contacted the Office and learned the fee could not be accepted because the patent had expired.

Petitioner contacted the Office of Petitions and was informed a patent can be reinstated by filing a grantable petition under 37 C.F.R. § 1.378(b) *with a surcharge of \$700* or by filing a grantable petition under 37 C.F.R. § 1.378(c) with a \$1,640 surcharge.

Petitioner filed a letter on January 27, 2012, requesting the Office accept the late submission of the \$1,500 without requiring payment of any additional fees. A credit card authorization form was filed with the January 27, 2012 letter.

On January 31, 2012, the Office contacted Petitioner and informed her that the credit card authorization form she submitted January 27, 2012, fails to identify the card's expiration date. Petitioner promptly submitted a corrected credit card authorization form, and \$1,500 was charged to the credit card on February 1, 2012.

Petitioner has submitted a copy of a February 10, 2012 letter from the Office to Petitioner. The letter states, with emphasis added,

[T]he USPTO may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to have been unavoidable or unintentional *and* if the surcharge required by section 1.20(i) is paid....

A petition to accept late payment of a maintenance fee, where the delay was unavoidable, *must* include ... the surcharge set forth in 37 CFR 1.20(i)(1).

The Office mailed a second document responding to the January 27, 2012 correspondence on March 5, 2012. The document states,

The required \$700 surcharge has not been submitted. Therefore, the merits of the petition under 37 C.F.R. § 1.378(b) will not be addressed at this time.

Petitioner has submitted the 7.5 year maintenance fee and an additional \$75. If Petitioner wishes for the Office to address the merits of the petition under 37 C.F.R. § 1.378(b), Petitioner must submit an additional \$625 (\$700 - \$25) within TWO MONTHS of the mailing date of this letter. Extensions of time may not be obtained. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." The failure to file a timely reply to the instant Request for Information

will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

If Petitioner does not wish to submit the additional \$625, Petitioner may request a refund of the \$1,500 submitted January 27, 2012. A request for a refund of the \$1,810 may be sent to: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this letter should accompany any request for refund.

If a response to the instant request and \$625 are filed, Petitioner should ensure the response includes *proof* Petitioner was unable to timely pay the fee. The current record fails to provide specific information regarding Petitioner's income, expenses, assets or liabilities.

If a response to the instant request and \$625 are filed, Petitioner should identify the nature of the card used to pay the 7.5 year maintenance fee on January 6, 2012. If the card was a credit card, Petitioner should explain why she needed to receive the January 6, 2012, prior to paying the fee with a credit card.

Petitioner may file a petition under 37 C.F.R. § 1.378(c) in response to the instant request instead of pursuing relief under 37 C.F.R. § 1.378(b) or requesting a refund of the \$1,500 filed January 27, 2012. A copy of a blank form which may be used to file such a petition is attached. A petition under 37 C.F.R. § 1.378(c) is different than a petition under 37 C.F.R. § 1.378(b) in two main respects.

- (1) (A) A petition under 37 C.F.R. § 1.378(b) must prove the entire delay in payment of a fee was unavoidable, and
- (B) A petition under 37 C.F.R. § 1.378(c) merely needs to state the delay in payment of the fee was unintentional.
- (2) (A) The surcharge for a petition under 37 C.F.R. § 1.378(b) is \$700, and
- (B) The surcharge for a petition under 37 C.F.R. § 1.378(b) is \$1,640.

Since Petitioner has already submitted \$1,500, the remainder of the fees due if a petition under 37 C.F.R. § 1.378(c) is \$1,565 (\$1,425 + \$1,640 - \$1,500).

On May 5, 2012, Petitioner submitted a two-page letter, copies of papers previously received by Petitioner, and copies of papers previously filed by Petitioner.

The May 5, 2012 letter requests the Office review Petitioner's extenuating circumstances communications" pertaining to this case and accept the \$1,500 payment.

Discussion

The circumstances under which a patent may be reinstated are set forth in 37 C.F.R. § 1.378. Specifically, a patent may only be reinstated upon the submission of a grantable petition under 37 C.F.R. § 1.378(b) or a grantable petition under 37 C.F.R. § 1.378(c).

A petition under 37 C.F.R. § 1.378(b) must include payment of a \$700 surcharge. Petitioner has not submitted the \$700 surcharge. Since the \$700 surcharge has not been submitted, a grantable petition under 37 C.F.R. § 1.378(b) has clearly not been filed.

A petition under 37 C.F.R. § 1.378(c) must include payment of a \$1,640 surcharge. Petitioner has not submitted the \$1,640 surcharge. Since the \$1,640 surcharge has not been submitted, a grantable petition under 37 C.F.R. § 1.378(c) has clearly not been filed.

Since neither a grantable petition under 37 C.F.R. § 1.378(b) nor a grantable petition under 37 C.F.R. § 1.378(c) has been filed, the patent cannot be reinstated.

Steps to be Taken if Petitioner Wishes to Pursue Relief Under 37 C.F.R. § 1.378(b)

If Petitioner wishes to pursue relief under 37 C.F.R. § 1.378(b), Petitioner must respond to the instant letter within TWO MONTHS of the mailing date of this letter. Extensions of the two-month time period may not be obtained. The response should be titled, "Response to Request for Information."

In order to obtain relief under 37 C.F.R. § 1.378(b), a party must submit a \$700 surcharge. Petitioner previously submitted \$75 of the surcharge. Therefore, the response must include an additional \$625.

A grantable petition under 37 C.F.R. § 1.378(b) must include the maintenance fee, the required surcharge, *and* the following showing:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Since the \$700 surcharge has not been submitted, the Office will not address the sufficiency of the current showing in this case.

As a courtesy, the Office reminds Petitioner that Petitioner bears the burden of proving the failure to timely pay the maintenance fee was unavoidable if a petition is filed under 37 C.F.R. § 1.378(b). In general, a showing that a party was unable to afford the total fee due (\$1,500 in this case), must include relevant financial information for the party at the time the fee fell due. For example, in this case, such information would include Petitioner's income, expenses, assets and liabilities for November and December 2011.

Petitioner submitted a credit card authorization form on January 6, 2012. If Petitioner wishes to pursue relief under 37 C.F.R. § 1.378(b), the Office strongly suggests Petitioner address the nature of the card identified on the credit card authorization form. If the card was a credit card rather than a debit card, the Office strongly recommends Petitioner explain why Petitioner

needed to receive the January 6, 2012 check prior to paying the maintenance fee with the credit card.

Steps to be Taken if Petitioner Wishes to Pursue Relief Under 37 C.F.R. § 1.378(c)

Petitioner may file a petition under 37 C.F.R. § 1.378(c). A form which may be used to file such a petition is attached. The petition should include an additional \$1,565 (\$1,640 - \$75) for the required surcharge.

Petitioner May Request a Refund of the \$1,500

If Petitioner does not wish to pursue relief under 37 C.F.R. § 1.378, Petitioner may request a refund of the \$1,500 previously submitted to the Office. A request for a refund of the \$1,500 may be sent to: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this letter should accompany any request for refund.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.¹
Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Anthony Knight
Director
Office of Petitions/
Petitions Officer

Attachments: Petition Under 37 C.F.R. § 1.378(c) Form
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¹ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.